

**REMARKS**

Claims 1-25 are pending in the application. Claims 1-10, 15-18, and 22-25 are allowed, while claims 14 and 21 are indicated to be allowable. Claims 11-13, 19 and 20 stand rejected under 35 U.S.C. §102(b) over U. S. Patent No. 6,012,640 to Liu ("Liu"). Claims 11-13, 19 and 20 also stand rejected under 35 U.S.C. §102(e) over U. S. Patent No. 6,834,806 to Benedetti ("Benedetti").

According to *MPEP* §2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

To expedite an allowance applicant has combined elements of claim 13 into claim 11 and have combined elements similar to those of claim 20 into claim 19 while removing certain elements from claims 11 and 19. Original dependent claims 13 and 20 recited elements relating to a first set of max min-peaks having amplitudes approximately equal to amplitudes of a second set of max min peaks.

Regarding claim 11, claim 11, as currently presented recites, among other elements, elements relating to a reader wherein a first set of max-min peaks attributable to signals and a second set of max-min peaks superimposed on a major peak attributable to noise are generated, discriminated to select the first set for digitization, and wherein the amplitudes of the first and second set are approximately equal. Claim 19 as currently presented recites similar elements in method form. Accordingly, claims 11 and 19 recite an apparatus (claim 11) and method (claim 19), respectively, wherein a set of max-min peaks are subject to digitization in spite of having amplitudes approximately equal to those of max-min peaks attributable to noise.

Applicant respectfully asserts that the Examiner has failed to establish that either Liu or Benedetti recites elements relating to digitizing a set of max-min peaks wherein

the set of max-min peaks have amplitudes approximately equal to max-min peaks attributable to noise.

The Examiner relies on Liu in rejecting claims 11 and 19. The relied upon section of Liu is as follows:

Referring to FIG. 6, a schematic waveform portion 250 includes a small peak 252 having a greater left neighboring peak 254, separated by a small valley 256. Under rule P5, the CPU 14 determines that if the combine flag equals possible, and since the left maximum peak 254 is greater than the left neighboring peak 254. As shown in FIG. 7, a resulting processed waveform portion 250' includes only the peak 254 and right neighboring value 270, without the small peak and valley 252 and 256. Under rule P6, the CPU 14 similarly merges the small peak 258 with the right neighboring peak 260 in the waveform 250, to produce the single peak 260, left of a valley 272, as shown in the waveform 250' of FIG. 7. *U. S. Patent No. 6,012,640, column 10, lines 23-36.*

As understood by the applicant, the relied upon section of Liu discusses once again only discarding sets of max-min peaks having small values (the passage describes discarding small peaks, "As shown in FIG. 7, a resulting processed waveform portion 250' includes only the peak 254 and right neighboring valley 270, without the small peak and valley 252 and 256.") However, applicant cannot determine from the office action of April 21, 2006 where in Liu the Examiner has referred to a teaching relating to digitizing max-min peaks having amplitudes approximately equal to amplitudes of max-min peaks attributable to noise as is recited in claims 11 and 19.

The Examiner also relies on Benedetti in rejecting claims 11 and 19. The relied upon section of Benedetti is as follows:

Essentially, a hysteresis is introduced in the recognition of the transitions, subordinating said recognition to a threshold—respectively higher or lower than the second comparison signal—being crossed, so as to prevent recognizing as transitions the small ripples of the video signal contained in the comparison signals A, B and due to noise. *U. S. Patent No. 6,834,806, column 11, lines 29-34.*

As understood by the applicant, the relied upon section of Benedetti discusses only discarding sets of max-min peaks having small values ("...so as to prevent recognizing as transitions the small ripples of the video signal contained in the comparison signals A, and B and due to noise."). However, applicant cannot determine from the office action of April 21, 2006 where in Benedetti the Examiner has referred to

a teaching relating to digitizing max-min peaks having amplitudes approximately equal to amplitudes of max-min peaks attributable to noise as is recited in claims 11 and 19.

In that the Examiner has not presented evidence indicating that all of the elements of claim 11 or claim 19 are present in either Liu or Benedetti, the Examiner has not established that either claim 11 or claim 19 is anticipated by the prior art.

Further regarding claims 11 and 19, the Examiner will note that "transition region" elements have been removed from those claims, and are now presented in dependent claims 27 and 28 respectively.

Regarding claims 29 and 30, claims 29 and 30 recite subject matter of original dependent claims 14 and 21, with certain base claim limitations removed. Original claims 14 and 21 were indicated to be allowable.

Regarding the dependent claims herein, the dependent claims are believed to be allowable for the reason that they depend from an allowable base claim and for the additional combination of elements the recite.

While the applicants herein may have highlighted a particular claim element for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such limited purpose should not be taken to indicate that the applicants have taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present.

None of the amendments presented herein contain new matter.

Accordingly, in view of the above amendments and remarks, applicant believes all of the claims of the present application to be in condition for allowance and respectfully requests reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: August 21, 2006

Respectfully submitted,

By George S. Blasiak  
George S. Blasiak  
Registration No.: 37,283  
WALL MARJAMA & BILINSKI LLP  
101 South Salina Street  
Suite 400  
Syracuse, New York 13202  
(315) 425-9000  
Customer No. 20874